



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,814	02/06/2004	Lukas Eisermann	31132.42	8262

46333 7590 12/14/2006

HAYNES AND BOONE, LLP
901 MAIN ST
SUITE 3100
DALLAS, TX 75202

EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
----------	--------------

3738

DATE MAILED: 12/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

88

Office Action Summary	Application No. 10/773,814	Applicant(s) EISERMANN ET AL.	
	Examiner Paul B. Prebilic	Art Unit 3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 25-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 25-39, 41 and 43-45 is/are rejected.
- 7) ☒ Claim(s) 40 and 42 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>9/21/04 + 8/6/04</u> . | 6) <input type="checkbox"/> Other: _____ |

Election/Restrictions

Claims 1-24 were withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on September 25, 2006.

Group I and Species L (Figures 28-31) were elected without traverse. Non-elected claims 1 to 24 were cancelled and the remaining claims and added claims were said to be drawn to the elected species.

Claim Objections

Claim 45 is objected to because of the following informalities:

In claim 45, line 2, "plant" appears to be a misspelling for the term "implant."

Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 29, 35, and 39 are rejected under 35 U.S.C. 102(e) as being anticipated by Geremakis et al (US 2004/0167626). Geremakis discloses a method of inserting an implant via a transforaminal approach as claimed; see the abstract and paragraphs [0014] and [0063]. For this reason, the claim language is fully met and anticipated.

With regard to claim 39, Applicants are directed to Figures 1 and 2 that show a ball and socket union.

Claims 25-29 and 35 are rejected under 35 U.S.C. 102(b) as being anticipated by Froning (US 3,875,595). Froning anticipates the claim language where the first component as claimed is the top stud (49) and upper wall of the prosthesis, and the second component as claimed is the bottom stud (49) and lower wall of the prosthesis; see Figures 1 to 7, column 1, lines 7-12 and column 2, line 25 to column 3, line 24.

With regard to claim 35, the assembling step is performed inherently while the device is manufactured.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 30-34, 36-38, 41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geremakis et al (US 2004/0167626) in view of Gerber et al (US 2004/0167538). Geremakis meets the claim language as explained in the first rejection above but fails to disclose the method steps of forming a transforaminal slot with tools

as claimed. However, Gerber teaches that it was known in the art to form transforaminal slots to insert similar implants within the art; see the figures and paragraph [0047]. Therefore, it is the Examiner's position that it would have been obvious to use tools such as in Gerber to carry out the method disclosed by Geremakis so as to perform the method more quickly and efficiently.

Claims 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Geremakis et al (US 2004/0167626) in view of Ferreira et al (US 7,018,412). Geremakis discloses spikes to prevent migration of the implant but not using grooves therefor. However, Ferreira teaches that it was known to put curved flanges in similar implants in order to prevent migration; see Figures 15 to 19 and column 6, line 33 et seq. Therefore, it is the Examiner's position that it would have been obvious to put curved flanges in the Geremakis implant for the same reasons that Ferreira does the same.

Claims 30-33, 36-38, 41, and 43-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Froning (US 3,875,595) in view of Gerber et al (US 2004/0167538). Froning meets the claim language as explained in the previous rejection but fails to disclose the method steps of forming a transforaminal slot with tools as claimed. However, Gerber teaches that it was known in the art to form transforaminal slots to insert similar implants within the art; see the figures and paragraph [0047]. Therefore, it is the Examiner's position that it would have been obvious to use tools such as in Gerber to carry out the method disclosed by Froning so as to perform the method more quickly and efficiently and to allow better access to the disk space.

Allowable Subject Matter

Claims 40 and 42 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 of 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action if the application is not stored in image format (i.e. the IFW system) or published.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Paul B. Prebilio whose telephone number is (571) 272-4758. He can normally be reached on 6:30-5:00 M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Prebilio
Primary Examiner
Art Unit 3738